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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,960	06/20/2000	D. Amnon Silverstein	10992107-1	5916

22879 7590 04/05/2005

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EXAMINER

SAID, MANSOUR M

ART UNIT PAPER NUMBER

2673

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

09/597,960

**Applicant(s)**

SILVERSTEIN, D. AMNON

**Examiner**

MANSOUR M SAID

**Art Unit**

2673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,4,8-11 and 15-20 is/are allowed.
- 6) ☒ Claim(s) 2,3,5-7 and 13 is/are rejected.
- 7) ☒ Claim(s) 12 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. This Office Action is in respond to the Notice if Appeal filed on February 10, 2005.
2. The finality dated on August 30, 2004 of claims 1-20 are withdrawn in view of the newly discovered reference(s) to Hideto Shimozato (JP 01-253194) and Yoshinaga Koji (JP 08-307272).
3. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection, and Rejections based on the newly cited reference(s) follow.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim limitation such as “sensor detecting housing volume changes” is not clear to the Examiner, what the Applicant referred to the “housing volume changes”, and the claim is not clear if the sensor connected to the mouse click, in order to detect the housing volume.

Correction is needed.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 2 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hideto Shimozato (JP H03-113624; hereinafter referred to as Hideto) in view of Yoshinaga Koji (JP 10-133813; hereinafter referred to as Koji).**

As to claim 2, Hideto teaches wherein the housing is collapsible into a relatively flat structure (relatively a flat structure shows in figure 2) (figures 1-2, specification page 4, lines 21-24 and page 5, 1-9).

As to claim 5, Hideto teaches a computer mouse (figures 1-2 and specification page 4, lines 7-9) comprising a motion sensor (encoder which senses X & Y directions of the mouse, (figure 1, (111)) and specification page 4, lines 19-20); and a collapsible housing for the motion sensor (encoder, (figure 1, (111)) and (specification page 4, lines 19-24), the collapsible housing (mouse in figure 2) including a rigid base (bottom plane spacer, (figure 1, (113-115)) and an upper portion (upper case, (figure 1, (101)) attached to the base (specification page 4, lines 7-19).

Hideto teaches the upper portion (upper case, (figure 1, (101)) that allows the housing to be collapsed (figure 2) and (specification page 4, lines 22-25 and page 5, lines 1-9).

Hideto does not expressly teach that the mouse upper portion made of an elastic material.

However, Koji teaches a folding mouse having upper portion (covering, (figure 5, a-b)) made of elastic material (elastic member, plastic) (figures 4-5, specification page 2, lines 9-16).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Koji's folding mouse having an elastic member and plastic material into Hideto's collapsible mouse so as to contract the holding part and the mouse device is made small (abstract).

As to **claim 6**, Hideto teaches a computer mouse (figures 1-2 and specification page 4, lines 7-9) comprising a motion sensor (encoder which senses X & Y directions of the mouse, (figure 1, (111)) and specification page 4, lines 19-20); and a collapsible housing (figure 2) for the motion sensor (encoder, (figure 1, (111)) and (specification page 4, lines 19-24), the collapsible housing (mouse in figure 2) collapses into a relatively flat structure (relatively a flat structure shows in figure 2) (figures 1-2, specification page 4, lines 21-24 and page 5, 1-9).

Hideto does not teach that a housing including a resilient plastic sheet having fold lines.

However, Koji teaches a freely foldable housing (figure 4) including a resilient plastic sheet having fold lines (figure 4b, (31-32)) clearly shows the folding lines on the housing) (specification page 2, lines 1-16).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Koji's folding mouse having an elastic member and plastic material including fold lines into Hideto's collapsible mouse so as to contract the holding part and the mouse device is made small (abstract).

As to **claim 7**, Koji teaches wherein the resilient plastic sheet includes a top portion (coverings, (figures 4-5, (31-32)) and specification 2, lines 4-16) and (page 3, paragraph 0020,

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lines 5-6), a base (bottom plane spacer, (figure 1, (113-115)) and specification 2, lines 4-16) (page 3, paragraph 0020, lines 5-6), and inwardly-collapsible sidewalls a freely foldable housing (figure 4) between the top portion (coverings, (figures 4-5, (31-32)) and the base (bottom plane spacer, (figure 1, (113-115)) (specification page 2, lines 1-16) (page 3, paragraph 0020, lines 5-6), the sidewalls having the fold lines (figure 4b, (31-32)) clearly shows the side wall of the cover is folding lines) (figure 4 and specification page 1, paragraph 0009, lines 1-3 and specification page 2, lines 1-6 and page 3, paragraph 0021, lines 1-8).

**8. Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hideto in view of Koji as applied to claim 5 above, and further in view of Dunton (6,337,919 B1).**

As claim 3, Hideto and Koji teach all claimed limitations except an optical sensor.

However, Liebenow teaches a pointing device (mouse) having an optical sensor (sensor, (figure 24)) (figures 1-3 and column 2, lines 6-14 and column 2, lines 23-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Dunton's mouse having an optical sensor into Hideto's modified input device so to capture the fingerprint in the right focal orientation regardless of whether the button is pushed or unpushed (column 2, lines 25-30).

As to claim 13, as best understood, Hideto and Koji teach a collapsible mouse comprising elastic member/plastic upper housing and a sensor.

Hideto and Koji do not expressly disclose the sensor detecting housing volume changes that correspond to mouse click.

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However, Dunton teaches the sensor detecting housing volume changes that correspond to mouse click (column 2, lines 27-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Koji's folding mouse having an elastic member and plastic material into Hideto's collapsible mouse so as to contract the holding part and the mouse device is made small (abstract).

***Allowable Subject Matter***

9. Claims 1, 4, 8-11 and 15-20 are allowed.
10. Claims 12 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mansour M. Said** whose telephone number is **(571) 272-7679**.

The examiner can normally be reached on Monday through Thursday from 8:30 a.m. to 6:00 p.m. The examiner can also be reached on alternate Friday from 8:30 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Shalwala Bipin**, can be reached at **(571) 272-7681**.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

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Washington, D.C. 20231

or faxed to:

**(703) 872-9314 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal


Drive, Arlington, VA, Sixth Floor (Receptionist)

12. 3Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer service Office whose telephone number is (703) 306-0377.

Patent Examiner

March 30, 2005

**Mansour M. Said**

  
BIPIN SHALWALA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600